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10/043,856	01/11/2002	Jean-Luc Pouss	22.1489	8450
7590	09/01/2010			
Patent Counsel Schlumberger Reservoir Completions Schlumberger Technology Corporation 14910 Airline Road Rosharon, TX 77583			EXAMINER ROSEN, NICHOLAS D	
ART UNIT	PAPER NUMBER		3625	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1                   UNITED STATES PATENT AND TRADEMARK OFFICE

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4                   BEFORE THE BOARD OF PATENT APPEALS  
5                   AND INTERFERENCES

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8                   *Ex parte JEAN-LUC POUS, DAVID L. MALONE,  
9                   IAN T. SCHUUR, and PETER A. GOODE*

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12                   Appeal 2010-001334  
13                   Application 10/043,856  
14                   Technology Center 3600

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17                   Before ANTON W. FETTING, JOSEPH A. FISCHETTI, and  
18                   BIBHU R. MOHANTY, *Administrative Patent Judges.*  
19                   FETTING, *Administrative Patent Judge.*

20                   DECISION ON APPEAL<sup>1</sup>

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

1 STATEMENT OF THE CASE<sup>2</sup>

2 Jean-Luc Pous, David L. Malone, Ian T. Schuur, and Peter A. Goode  
3 (Appellants) seek review under 35 U.S.C. § 134 (2002) of a final rejection of  
4 claims 42-62, the only claims pending in the application on appeal. We have  
5 jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

6 The Appellants invented a way of supplying custom engineered products  
7 (Specification 2: Field of Invention). An understanding of the invention can  
8 be derived from a reading of exemplary claim 42, which is reproduced  
9 below [bracketed matter and some paragraphing added].

10 42. A method comprising:

11 [1] providing an online catalog on a computer,

12       the catalog having an unavailable product/attribute  
13       selector to select an unavailable product or attribute that  
14       is not offered for sale; and

15 [2] using selections of unavailable products or attributes that are  
16 not offered for sale obtained via the unavailable  
17 product/attribute selector as market research

18       to determine whether to extend a product offering that  
19       includes the unavailable products or attributes.

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<sup>2</sup> Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed June 8, 2007) and Reply Brief ("Reply Br.," filed November 5, 2007), and the Examiner's Answer ("Ans.," mailed September 4, 2007).

1       The Examiner relies upon the following prior art:

Joseph	US 5,878,401	Mar. 2, 1999
House	US 6,785,805 B1	Aug. 31, 2004
Hunter	US 6,850,901 B1	Feb. 1, 2005

2       *EMCORE Announces Expectations For Record Year End Revenue And*  
3       *Substantial Increases In 2001 Backlog.* Business Wire, October 30, 2000  
4       at p. 0144 (hereinafter referred to as "Emcore")

5       Claims 42, 44, 45, 53, 54, and 56-59 stand rejected under 35

6       U.S.C. § 103(a) as unpatentable over House and Emcore.

7       Claim 51 stands rejected under 35 U.S.C. § 103(a) as unpatentable over  
8       House, Emcore, Official Notice, and Hunter.

9       Claim 43 stands rejected under 35 U.S.C. § 103(a) as unpatentable over  
10      House, Emcore, and Joseph.

11      Claims 46-50, 52, 55, 60, and 62 stand rejected under 35 U.S.C. § 103(a)  
12      as unpatentable over House, Emcore, and Official Notice.

13      Claim 61 stands rejected under 35 U.S.C. § 103(a) as unpatentable over  
14      House, Emcore, Joseph, and Official Notice.

15

## 16                   ISSUES

17      The issue of obviousness hinges on whether it was predictable for House  
18      to use data from product customization requests to extend its product line.

1                   FACTS PERTINENT TO THE ISSUES

2         The following enumerated Findings of Fact (FF) are believed to be  
3         supported by a preponderance of the evidence.

4         *Facts Related to Claim Construction*

5         01. The disclosure states that “[a]n unavailable product/attribute []  
6                 is one that the seller does not currently offer and that requires  
7                 engineering, testing, or both before it may be produced/sold.”  
8                 Specification 6:9-11.

9         *Facts Related to the Prior Art*

10         *House*

11         02. House is directed to network-based methods for configuring  
12                 and building integrated systems, such as integrated test,  
13                 automation, and/or measurement systems. The methods may be  
14                 internet or intranet-based applications that configure and price an  
15                 integrated system in response to selection of system features  
16                 and/or system configurations by a network user. House 1:16-18.

17         03. House provides online and offline selection tools to identify  
18                 individual components. The components may be off the shelf or  
19                 custom designed and made. House 2:12-27; 48-63.

20         04. The customized components may require engineering design  
21                 and test services to complete. House 4:59 – 5:3; 5:34-40.

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23

1 *Encore*

2           05. Emcore is directed to a notice that Emcore would increase R&D  
3           expenditures to capitalize on new market opportunities. Emcore  
4           1:1<sup>st</sup> ¶.

5 06. Emcore stated that such increases were in direct response to  
6 customer demand. Emcore 1:5<sup>th</sup> ¶.

## ANALYSIS

8       Claims 42 and 56 are the only independent claims and the only claims  
9       argued. Accordingly the remaining claims stand or fall with their parent  
10      claims.

11 The Appellants argue that the art fails to show a reason for one to have  
12 expanded a product line based on selection of an unavailable  
13 product/attribute selector of an online catalog as required by limitation [2] of  
14 claim 42. Appeal Br. 10-11. The Examiner found that this was mere  
15 product development based on customer demands made apparent by requests  
16 for customization in House. Ans. 13-14. The Appellants characterize the  
17 Examiner's findings as an obvious to try analysis, and argue that the  
18 Examiner has not shown a solution to the problem in the art. Reply Br. 2-3.  
19 The Appellants also argue for the first time that House does not describe an  
20 unavailable product/attribute selector for an unavailable product or attribute  
21 that is no offered for sale. Reply Br. 3.

22 As to the most recent argument regarding whether House offers  
23 unavailable products, we find that the Appellants have acted as their own  
24 lexicographer and defined an unavailable product as “one that the seller does

1 not currently offer and that requires engineering, testing, or both before it  
2 may be produced/sold.” FF 01. House offers to add components it does not  
3 currently sell, but may be custom made, in its test systems. FF 03. These  
4 customized components may require engineering design and test services to  
5 complete. FF 04. Accordingly, we find that House does offer unavailable  
6 products in its online system (catalog).

7 As to the reason for combining the references to have expanded a  
8 product line based on selection of an unavailable product/attribute selector  
9 of an online catalog, the Examiner articulated a compelling line of reasoning  
10 that recognized customer demand would typically trigger an expansion in a  
11 product line with the rational underpinning being evidence in the form of  
12 Emcore. The Examiner elaborated on this at Answer 13-16 and we adopt  
13 those Examiner’s findings and rationale.

14 “[R]ejections on obviousness grounds cannot be sustained by mere  
15 conclusory statements; instead, there must be some articulated reasoning  
16 with some rational underpinning to support the legal conclusion of  
17 obviousness”). *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007)  
18 citing *In re Kahn*, 441 F.3d 977, 988 (C.A.Fed.2006).

19 This is not an obvious to try analysis, as one of ordinary skill would have  
20 known exactly how to implement the resultant method – merely observing  
21 sales statistics to decide to make standard what was already custom designed  
22 and built. This is standard product marketing fare.

23 Claim 56 is to a system that is used to perform the method of claim 42.  
24 Since this is a system claim, certain structural elements are added that are  
25 not explicit in claim 42, such as a processor to compile the selections. The

1 Appellants argue that the art fails to describe a processor to compile the  
2 selections as recited in claim 56. Appeal Br. 12. The Examiner responded  
3 that for House to see which custom designs (unavailable products) were  
4 worthy of making standard, some compilation must have been performed  
5 and House has the server that would have the capacity to do such a  
6 compilation. Ans. 16. We agree with the Examiner for those reasons.

7

#### 8 CONCLUSIONS OF LAW

9 Rejecting claims 42, 44, 45, 53, 54, and 56-59 under 35 U.S.C. § 103(a)  
10 as unpatentable over House and Emcore is not in error.

11 Rejecting claim 51 under 35 U.S.C. § 103(a) as unpatentable over  
12 House, Emcore, Official Notice, and Hunter is not in error.

13 Rejecting claim 43 under 35 U.S.C. § 103(a) as unpatentable over  
14 House, Emcore, and Joseph is not in error.

15 Rejecting claims 46-50, 52, 55, 60, and 62 under 35 U.S.C. § 103(a) as  
16 unpatentable over House, Emcore, and Official Notice is not in error.

17 Rejecting claim 61 under 35 U.S.C. § 103(a) as unpatentable over  
18 House, Emcore, Joseph, and Official Notice is not in error.

19

#### 20 DECISION

21 To summarize, our decision is as follows.

- 22 • The rejection of claims 42, 44, 45, 53, 54, and 56-59 under 35 U.S.C.  
23 § 103(a) as unpatentable over House and Emcore is sustained.

- 1     • The rejection of claim 51 under 35 U.S.C. § 103(a) as unpatentable  
2         over House, Emcore, Official Notice, and Hunter is sustained.
- 3     • The rejection of claim 43 under 35 U.S.C. § 103(a) as unpatentable  
4         over House, Emcore, and Joseph is sustained.
- 5     • The rejection of claims 46-50, 52, 55, 60, and 62 under 35  
6         U.S.C. § 103(a) as unpatentable over House, Emcore, and Official  
7         Notice is sustained.
- 8     • The rejection of claim 61 under 35 U.S.C. § 103(a) as unpatentable  
9         over House, Emcore, Joseph, and Official Notice is sustained.

10         No time period for taking any subsequent action in connection with this  
11         appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.  
12         § 1.136(a)(1)(iv) (2007).

13

**AFFIRMED**

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18         mev

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20         Address

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